

Customer No.: 07055

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant(s) : Dr. Rudiger KURTZ

Group Art Unit: 1734

Appln. No. : 10/619,424

Examiner: B. A. Lamb

Filed : July 16, 2003

Confirmation No.: 7328

For : DEVICE AND PROCESS FOR IMPREGNATING A PAPER OR
CARDBOARD WEB

REQUEST FOR PRE-APPEAL BRIEF REVIEW

Commissioner for Patents
U.S. Patent and Trademark Office
Customer Service Window, Mail Stop AF
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Sir:

This request is being filed concurrently with a Notice of Appeal and is responsive to the Final Office Action of July 27, 2006, the period for response extending to October 27, 2006.

While no fees are believed necessary to ensure consideration of the instant Request, should any fees be deemed necessary, the undersigned authorizes the charging of any fees, including extensions of time fees required to place the application in condition for allowance by Examiner's Amendment, to Deposit Account No. 19-0089 in order to maintain pendency of this application.

Reconsideration and withdrawal of the single 35 U.S.C. § 103(a) rejection is respectfully requested in view of the following remarks.

A prima facie case of unpatentability has not been set forth, such that the rejection under 35 U.S.C. § 103(a) is improper.

Examiner's Assertion:

While not disclosed in WO 01/98585 [hereinafter "WO '585"], it would have been obvious to one ordinarily skilled in the art that the apparatus is capable of elastic compression of the web, and that it would have been obvious to one ordinarily skilled in the art to set a distance between the wide nip calender and the coating device so that the undisclosed feature of elastic compression of the web is still present when the web enters the coating device.

Applicant's Reply:

The Examiner, in contrast to the pending claims, has not shown any teaching or suggestion of *elastic compression* of the web, and *setting a distance* between the wide nip calender and the coating device so that the *elastic compression* of the web by the wide nip calender is still present when the web enters the coating device, as recited in at least independent claims 1 and 33.

Applicants submit that WO '585 expressly discloses that the nip produces a *permanent compression*, see, e.g., page 9, line 1 and the Abstract, which is wholly inconsistent with expressly recited features of *elastic compression*. Additionally, WO '585 discloses on page 4, line 23 to page 5, line 7 that the apparatus is operated such that fibers at the surface of the web are brought to a state of *plastic deformation*

(*permanent compression*) in the wide nip calender, while fibers in the middle of the z-direction may be *left unaffected*, wherein the bulkiness of the paper is maintained.

Thus, Applicants submit WO '858 expressly discloses *plastic deformation (permanent compression)* of a surface of a web and leaving a middle portion of the web unaffected. Applicants submit neither permanent compression, nor not affecting a portion of the web, provides any arguable teaching or suggestion for the recited elastic compression of the web, as recited in at least independent claims 1 and 33. That is, in permanent compression the web (or portion) is compressed and stays that way, and when a portion of a web is left unaffected, no deformation occurs. Both of these are stark contrasts to the recited elastic compression in which the web is compressed and then subsequently expands.

Furthermore, absent Applicants' disclosure, there is no reasonable rationale to infer WO '858 is capable of being operated to achieve elastic compression of the web, or that WO '858 even recognizes any benefit to doing so. Moreover, as WO '858 expressly discloses the fibers in the middle in the z-direction of the paper web are left unaffected, Applicants submit there is no teaching or suggestion of the recited elastic compression. Therefore, Applicants submit it would not have been obvious to one skilled in the art to modify WO '858 in order to elastically compress a web, as such a modification is contrary to the express disclosure of the applied art.

Additionally, as WO '858 does not teach or suggest an elastic compression of the web, Examiner's contention that it would have been obvious to set a distance between the wide nip calender and the coating device such that the elastic compression of the web by the wide nip calender is still present when the web enters the coating device is

certainly not supportable. As discussed above, WO '858 does not teach or suggest elastic compression, but rather plastic (permanent) compression of a surface of the web and not affecting the inner portion of the web. The Examiner contends that the capability of an elastically compressed web to be present in the coating device is dependent upon the amount of resiliency of the web and degree of compression of the web, but she has not identified any disclosure in WO '858 to support her contention. Applicants submit, however, as there is no elastic compression, there is no basis in the applied art to support the Examiner's contention of obviousness.

Further, Applicants note that, as the art of record fails to provide any teaching or suggestion of elastic compression of the web, the art of record fails to suggest the requisite motivation or rationale for modifying WO '585 in any manner that would render unpatentable the combination of features recited in at least independent claims 1 and 33. Examiner has not identified or stated any motivation or rationale for modifying WO '585, as required for a proper rejection under 35 U.S.C. § 103(a). Applicants respectfully request that the Examiner specifically identify a proper motivation for modifying WO '585 if this rejection is maintained.

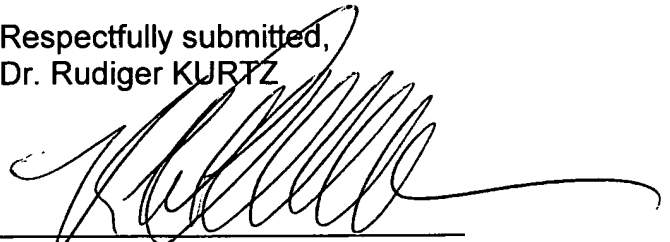
Moreover, as the Examiner's asserted modification of WO '585 is wholly contrary to the express disclosure of WO '585, i.e., the applied art expressly requires permanent *not* elastic compression of the web, or leaving a portion of the web unaffected, Applicants submit that the only reasonable basis for modifying WO '585 is the use of improper hindsight after reviewing Applicants' own disclosure. Thus, Applicants submit that, for this additional reason, the pending rejection is improper and should be withdrawn.

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Accordingly, Applicants request that the Examiner's decision to finally reject independent claims 1 and 33, as well as claims 2 – 15, which depend from claim 1, be withdrawn and the application be returned to the Examiner for allowance.

Respectfully submitted,
Dr. Rudiger KURTZ



Neil F. Greenblum
Reg. No. 28,394

Robert W. Mueller
Reg. No. 35,043

October 27, 2006
GREENBLUM & BERNSTEIN, P.L.C.
1950 Roland Clarke Place
Reston, VA 20191
(703) 716-1191